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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Y. OSHIDA, et al
Serial No.: 09/678,652
Filed: October 4, 2000
For: METHOD OF INSPECTING A DNA CHIP AND AN
APPARATUS THEREOF
Group: 1655
Examiner: B. Sisson

RESPONSE

Commissioner for Patents
Washington, D.C. 20231

December 7, 2001

Sir:

The following remarks are respectfully submitted in connection with the above-identified application in response to the Office Action dated November 7, 2001.

The requirement for restriction to one of the inventions identified as invention I - claims 1-11 and 18-29, drawn to a DNA inspection method, and invention II - claims 12-17 and 30-35, drawn to a DNA inspection apparatus, is traversed, and reconsideration and withdrawal of the restriction requirement are respectfully requested.

The Examiner has referred to the requirements of MPEP §806.05(h), indicating that inventions I and II are related as product and process of use, and applicants submit that the

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- Examiner has mischaracterized the inventions. Applicants submit that the proper characterization would be that of a process and apparatus for its practice in accordance with MPEP §806.05(e). It is noted that the requirements for showing distinctness are in terms of the process as claimed and the apparatus as claimed, and are somewhat similar to the requirements of MPEP §806.05(h). It is noted that referring to MPEP §806.05(h), it is indicated that "The burden is on the Examiner to provide an example, but the example need not be documented". The Examiner, as required by MPEP §806.05(h) has failed to provide an example, merely indicating that in the instant case, the method of claim 22 does not require a DNA chip nor the splitting of the beam of light as required by the apparatus of claim 12 and claims 13-17 that depend therefrom. Applicants note that apparatus claims 30, 31 and 35 also do not require a DNA chip which is not required by the method of claim 22 and, for example, with respect to splitting of the beam of light, it is noted that method claim 1 does not require the same, but dependent claim 4 recites the feature of a beam splitter. Applicants submit that when the method claims and the apparatus claims are considered in terms of the claimed features when looking to the independent and dependent claims, the requirements of MPEP §806.05(e) or MPEP §806.05(h) have not been satisfied, noting that clearly the Examiner has not provided an example as required by MPEP §806.05(h).

Therefore, applicants submit that the requirement for showing distinctness in accordance with the MPEP has not been satisfied, and the requirement for restriction should be withdrawn.

In order to provide a complete response to the restriction requirement, applicants provisionally elect, with traverse, invention I including claims 1-11 and 18-29.

In view of the above remarks, reconsideration and withdrawal of the restriction requirement and favorable action with respect to all claims present in this application are respectfully requested.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.39147X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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